



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,403	05/25/2001	Randal J. Jolitz	13370.0003.000000	4275

7590 10/21/2002

Christopher R. Benson
Howrey Simon Arnold & White, LLP
750 Bering Drive
Houston, TX 77057-2198

EXAMINER

SAFAVI, MICHAEL

ART UNIT PAPER NUMBER

3673

DATE MAILED: 10/21/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,403

Applicant(s)

JOLITZ, RANDAL J.

Examiner

M. Safavi

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3635

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 9 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification had not originally presented a roofing shingle comprising 40% polymer and 60% filler. Nor, had the specification originally presented a roofing shingle comprising 40% polyethylene and 60% filler.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 3635

4. Claims 1-6, 9, and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Bieser et al. Bieser et al. discloses a tile formed of a composition mixture of about 36 to 64% polyethylene and about 36 to 64% crushed limestone, col. 8, lines 8-45. The tile being less than an inch thick and between about 3-12 inches wide and between about 6-24 inches long, col. 11, lines 50-52.

5. Claims 1-5 and 7-13, are rejected under 35 U.S.C. 102(a) as being anticipated by Wells et al. Wells et al. discloses a tile formed of a composition mixture of about 36 to 64% polyethylene and about 36 to 64% crushed limestone, col. 6, line 38 to col. 7, line 10 which would include either 40% polymer and 60% filler or 40% polyethylene and 60% filler. The tile being between about 3-12 inches wide. col. 6, lines 27-29. Fillers may include slate and shale, col. 7, lines 4-5 with appearances of wood shake and slate tile, col. 4, lines 3-5.

6. Claims 1-5 and 7-13 are rejected under 35 U.S.C. 102(a) as being anticipated by Wells. Wells discloses a tile formed of a composition mixture of about 36 to 64% polyethylene and about 36 to 64% crushed limestone, col. 7, lines 35-60 and claim 13 which would include either 40% polymer and 60% filler or 40% polyethylene and 60% filler. Fillers may include slate and shale, col. 3, lines 34-36 with appearances of wood shake and slate tile, col. 4, lines 65-67.

Art Unit: 3635

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Wells et al. or Wells in view of Thompson et al.

Thompson et al. discloses formation of polymeric tiles having a dimension of between about 3-12 inches wide and between about 6-24 inches long, col. 5, lines 23-26. To have formed the tiles of either of Wells et al. or Wells with a dimension of less than an inch thick and between about 3-12 inches wide and between about 6-24 inches long, thus creating a tile presenting an aesthetically pleasing appearance, would have constituted an obvious expedient to one of ordinary skill in the art as taught by Thompson et al.

Response to Arguments

9. Applicant's arguments filed July 25, 2002 have been fully considered but they are not persuasive. The percentages disclosed in each of Bieser et al., Wells et al., and Wells do serve to read upon the percentages presented within claims 1, 6, 9, and 14.

Wells discloses an example of a tile utilizing 40% by weight polyethylene, as at line 45-48 of col. 7 and goes on to state that such would provide more flexibility. This meets the claim

Art Unit: 3635

limitation to “about 36% to 64% polymer and about 36% to 64% filler” as well as “40% polymer and 60% filler” and also expresses a desire for increased flexibility as stated at the top of page 2 of the instant disclosure.

The Wells et al. disclosure of polymer “...within the range of *about* 12 to *about* 35 percent by weight and a filler material in an amount within the range of from *about* 65 to *about* 88 percent by weight would serve to read upon the claim limitation of “*about* 36% to 64% polymer and *about* 36% to 64% filler”. Applicant allusion to the “background of the Invention” section has been noted. However, the instant disclosure does not serve to distinguish the claimed invention from the disclosure of Wells et al., (or either of Wells and Bieser et al.), in that the claims state approximate ranges with the “Summary of the Invention” stating that the blend of the instant invention “includes 70-35% polymer and 30-65% filler”. This range is met by Wells et al.

The Bieser et al. disclosure at lines 1-7 and 33-45 of col. 8 present a range or ranges, (e.g., 5%-70% of polymer and 30%-95% of filler), serving to read upon the ranges presented within the instant specification and the presently rejected claims.

Thus, when taking M.P.E.P. 2131.03 into consideration, the claimed subject matter is disclosed by the applied prior art with sufficient specificity to constitute an anticipation under the statute. And, there appears no evidence of unexpected results as to the claimed range when compared to the applied prior art with Bieser et al. stating “...compositions of the present invention withstand such high filler levels without suffering a corresponding sacrifice of physical

Art Unit: 3635

properties”; Wells stating “...up to 40 percent by weight...[polyethylene]...provides more flexibility to the shingle; and Wells et al. stating “...provides more flexibility to the shingle”.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (703) 308-2168.

M. Safavi
October 19, 2002



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**